

REMARKS

By this Amendment, claims 35, 41-54, and 63 are amended. The claims are amended solely to improve clarity and to direct the claims to the elected SEQ ID NOs. Support for the amendments to the claims comes from the specification and claims, as originally filed.

Accordingly, no new matter is added by this Amendment. Currently, claims 26-35 and 41-63 are pending in this application.

I. *Restriction Requirement*

In a Restriction Requirement dated April 22, 2003, the Examiner required restriction of the claims based on the SEQ ID NOs recited in the claims. (Restriction Requirement at pages 2-3.) The Examiner stated that up to 10 sequences will be examined in this application, and requested that Applicants elect the 10 sequences to be examined. In response, Applicants elect SEQ ID NO:21 through SEQ ID NO:30, *with* traverse.

A. The Recited Sequence Identifiers Are Related

The Examiner relies on 35 U.S.C. § 121, 37 C.F.R. § 1.141, and MPEP § 2434 to assert that it is proper to limit the present claims to only 10 recited sequences. Applicants respectfully submit that the Examiner has misinterpreted the provisions of the cited statute, rule, and examination guideline, and thus improperly restricted the claims based on SEQ ID NOs. More specifically, the current U.S. PTO policy on examination of nucleic acid or amino acid sequences is that nucleic acids that encode the same protein are not independent and distinct inventions, and thus will not be subject to restriction from each other. MPEP §§ 803.04, 2434. Applicants submit that this policy should be applied to the present claims for the following reasons.

As discussed on pages 4-5 and 11-15 of the present specification, all of SEQ ID NOs:1-58 are part of the human tenascin cDNA sequence. The full length sequence is represented by SEQ ID NO:1. Oligonucleotides that comprise sequences of one strand of the cDNA are represented by SEQ ID NOs:2-20. The sequences of SEQ ID NOs:21-39 and SEQ ID NOs:40-58 correspond to the sequences of SEQ ID NOs:2-20, but contain modified sugar-phosphate backbones. Alteration of the sugar-phosphate backbone does not alter the sequence of the bases of the oligonucleotides. In summary, all of SEQ ID NOs:1-58 contain sequences of the same gene encoding the same protein - human tenascin. Accordingly, using the definition provided by the U.S. PTO, all of these SEQ ID NOs are related. Therefore, restriction of the claims based on SEQ ID NO is improper. For at least this reason, Applicants request that the Examiner reconsider and withdraw the Restriction Requirement, and examine all of the recited SEQ ID NOs in this application.

B. The Office Has Already Searched All 58 Sequences

Regardless of the relatedness of SEQ ID NOs:1-58, Applicants submit that restriction of the claims based on SEQ ID NOs at this point in prosecution is improper because the Office has already searched and examined all 58 recited sequences. (See the Office Action of April 24, 2001.) There can be no serious additional burden on the Examiner to search and examine subject matter that has already been searched and examined in this application. Indeed, the burden of the search and examination of the full scope of the claims has already been determined by the Office to be reasonable and acceptable. For at least this reason, Applicants request that the Examiner reconsider and withdraw the Restriction Requirement, and continue to examine all of the recited SEQ ID NOs in this application, in accordance with examination to date.

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II. *Conclusion*

Applicants submit that the Restriction Requirement was issued improperly, and request that it be withdrawn. If it is to be withdrawn, and the Examiner finds all of the pending claims to be in condition for allowance, Applicants request that the Examiner contact their undersigned representative at the telephone number or e-mail address below to provide Applicants an opportunity to amend the claims to provide specific coverage for embodiments that might have been eliminated by the present Amendment. If the Office believes anything else is necessary in order to place this application in even better condition for allowance, Applicants request that their undersigned representative be contacted at the telephone number or e-mail address listed below.

If there is any petition or fee due in connection with the filing of this Amendment and Response that is not submitted herewith, please grant the petition and charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Date: September 22, 2003

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